

#19/ Reply Brief  
4/26/02  
A.S.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

APPLICANT(s): SHAW ET AL.

SERIAL NO.: 09/074,093 ART UNIT: 2684

FILING DATE: 5/7/98 EXAMINER: A. Gantt

TITLE: PORTABLE RADIO RECEIVED

ATTORNEY

DOCKET NO.: 200-007950-US (PAR) APR 25 2002

Technology Center 2600

Commissioner of Patents

Washington, DC 20231

ATTENTION: USPTO BOARD OF PATENT APPEALS AND INTERFERENCES

APPELLANTS' REPLY BRIEF

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In addition, to the various legal issues raised by Appellant in the brief dated January 21, 2002, it is also respectfully submitted that the Examiner has not set forth the factual evidence to support a proper and valid rejection of the claims under 35 U.S.C. 103 (a). As stated in In re Lee 61 USPQ2d 1430 @ page 1433-1434:

[1] As applied to the determination of patentability vel non when the issue is obviousness, "it is fundamental that rejections under 35 U.S.C. §103 must be based on evidence comprehended by the language of that section." *In re Grasselli*, 713 F2d 731, 739, 218 USPQ 769, 775 (Fed. Cir. 1983). The essential factual evidence on the issue of obviousness is set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966) and extensive ensuing precedent. The patent examination process centers on prior art and the analysis hereof. When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. See, e.g., *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001) ("the central question is whether there is reason to combine [the] references," a question of fact drawing on Graham factors).

"The factual inquiry whether to combine references must be thorough and searching." Id. It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. See, e.g., *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 USPQ2d, 1456, 1459 (Fed. Cir. 2000) ("a showing of a suggestion, teaching or motivation to combine the prior art references is an 'essential component of an obvious holding'") (quoting *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998)); *In re Dembiczaik*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references."); *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) (there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant); *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) ("'teachings of references can be combined only if there is some suggestion or incentive to do so.'") (emphasis in original) (quoting *ACS Hosp. Sys., Inc. v.*

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In view of the arguments presented above and those presented in APPELLANT'S BRIEF it is respectfully requested that the Examiner's rejections of Claims 1-27 be reversed.

Respectfully submitted,

Melvin J. Scolnick (Reg. No. 25, 233)

4/17/02

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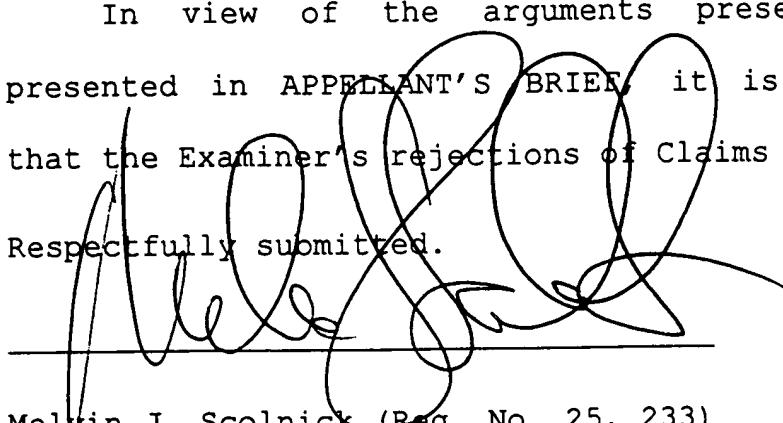
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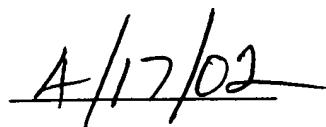
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